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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,705	08/05/2003	Philip D. Nguyen	2003-IP-010039U1	7548

7590 06/07/2005

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EXAMINER

FULLER, BRYAN A

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,705

Applicant(s)

NGUYEN, PHILIP D.

Examiner

Bryan A. Fuller

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 39 is/are pending in the application.
- 4a) Of the above claim(s) 23 - 35, & 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2 - 7, 9 - 14, 16 - 21, & 36 - 38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/5/03, 12/2/04 (6)</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 2 – 7, 9 – 14, 16 – 21, and 36 - 38, drawn to a method of using a fluid in a subterranean formation, classified in class 166, subclass 281.
 - II. Claims 23 – 35 and 39, drawn to a coated, treated particulate material used for treating subterranean formations and method of preparing the same, classified in class 428, subclass 403.
2. The inventions are distinct, each from the other because:
3. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the cement fluid can be used as a filler outside the area of wellbores or as an earth support fluid.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Robert Kent on 5/24/2005 a provisional election was made without traverse to prosecute the invention of Group I claims 2 – 7, 9 – 14, 16 – 21, and 36 - 38. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23 – 35 and 39 are withdrawn from further

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consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 2 – 7, 9 – 14, 16 – 21, and 36 – 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Nguyen et al (6,209,643).

With respect to claims 2 – 7, 9 – 14, 16 – 21, and 36 – 38: Nguyen et al teaches in column 4, line 15 – column 10, line 55 a method of treating a subterranean formation by providing a coated, treated particulate material comprising a treating agent adsorbed on a particulate material and an outer coating that comprises a coating material, the outer coating at least partially encapsulating the particulate material; and introducing the coated, treated particulate material into a subterranean formation. Although the reference does not teach a degradable outer coating, it does however teach the use of a tackifying outer coating that is made of the same compound that is used as the degradable coating material in the application. Therefore, it would be inherent that the same compound used as a tackifying coating would also be degradable. The reference teaches that the coated, treated particulate material can be used in forming a gravel pack or creating a proppant pack in a fracture.

The reference teaches the use of a particulate material that has at least one recessed or depressed area along a surface of the particulate material. The reference teaches the use of a gel breaker as a treating agent. The reference also teaches the use of a polycarbonate, which is a degradable coating material. Finally, the reference teaches the use of an alcohol as a solvent in the degradable coating material.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2 – 7, 9 – 14, 16 – 21, and 36 – 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen et al in view of Goodhue, Jr. et al (5,663,123).

With respect to claims 2 – 7, 9 – 14, 16 – 21, and 36 – 38: Nguyen et al teaches the features as claimed except specifying that their coating material is degradable. Goodhue, Jr. et al teaches in column 8, lines 7 – 41 the use of a degradable coating material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Nguyen's method by including a degradable coating material in view of the teachings of Goodhue, Jr. et al. The motivation for the combination of these two references is that the degradable coating material of Goodhue, Jr. et al maintains earth support fluids that are more functionally effective.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan A. Fuller whose telephone number is (571) 272-8119. The examiner can normally be reached on M - Th 7:30 - 5:00 and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David J. Bagnell
Supervisory Patent Examiner
Art Unit 3672

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